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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL
for FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 500**Complete if Known**

Application Number	10/056,312
Filing Date	January 24, 2002
First Named Inventor	Daryl S. Meredith et al.
Examiner Name	I. Hamilton
Art Unit	3724
Attorney Docket No.	TN-1488

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : _____☒ Deposit Account Deposit Account Number: 02-2548 Deposit Account Name: Black & Decker (U.S.) Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee(\$)	Fee Paid (\$)
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_____ -20 or HP= _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee(\$)	Fee Paid (\$)
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_____ - 3 or HP= _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

Fees Paid (\$)

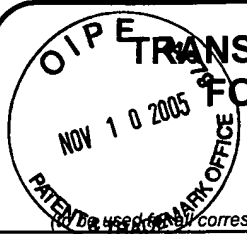
\$500

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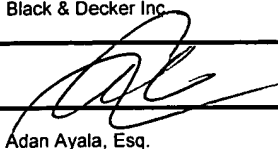
Signature		Registration No. (Attorney/Agent)	38,373	Telephone	410-716-2368
Name (Print/Type)	Adan Ayala, Esq.	Date	November 9, 2005		

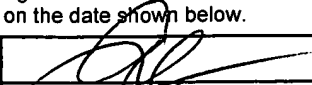
This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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	Application Number	10/056,312
	Filing Date	January 24, 2002
	First Named Inventor	Daryl S. Meredith et al.
	Art Unit	3724
	Examiner Name	I. Hamilton
Total Number of Pages in This Submission	Attorney Docket Number	TN-1488

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Post Card
<div style="border: 1px solid black; padding: 2px;">Remarks</div>		

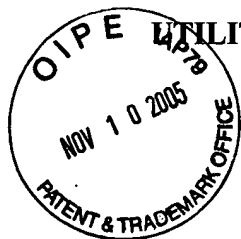
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Black & Decker Inc.		
Signature			
Printed Name	Adan Ayala, Esq.		
Date	November 9, 2005	Reg. No.	38,373

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Adan Ayala, Esq.	Date	November 9, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 10/056,312



B&D No. TN -1488

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Daryl S. Meredith et al.**

Serial No.: **10/056,312**

Examiner: **I. Hamilton**

Filed: **January 24, 2002**

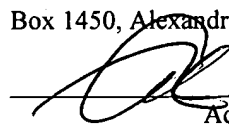
Group Art Unit: **3724**

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

REPLY BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on Nov. 9, 2005


Adan Ayala

Dear Sir:

This is in response to the Examiner's Answer mailed on September 22, 2005.

As to the Ushiwata/Tsune combination, the Examiner has admitted that Ushiwata discloses all elements called for in Claim 1 except for the second gear being driven by the motor via a belt.

The Examiner relies on Tsune to provide such missing element because "it would have been obvious to provide a belt in Ushiwata as taught by Tsune in order to provide a backlash eliminator assembly, which eliminates backlash between gears."

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As discussed in the Appeal Brief, this rejection is improper as the Examiner has failed to find some suggestion or motivation to one of ordinary skill in the art to combine the reference teachings. When called upon to provide such motivation, the Examiner argued that the motivation to provide a belt can be found in Tsune “in order to provide a backlash eliminator assembly, which eliminates backlash between gears.” However, Tsune does not teach using a belt to provide a backlash eliminator, as fully explained in the Appeal Brief. Because the belt does not provide the functionality claimed by the Examiner, the alleged motivation to combine is invalid.

In view of such facts, the Examiner then admitted that “the belt and pulley system are not a part of the backlash eliminator.” However, the Examiner argued “the belt and pulley are required in the configuration of any apparatus that has the backlash eliminator because of the spatial arrangements and spatial constraints.” In other words, the belt and pulley system are needed in all apparatus that have a backlash eliminator.

In response, Applicants/Appellant pointed out that US Patent No. 5,823,081 (“Tsune ‘081”) disclosed a circular saw with a backlash eliminator without a belt or pulleys. In other words, “any apparatus that has the backlash eliminator” does not require a belt and pulley, as alleged by the Examiner.

In the Examiner’s Answer, the Examiner now argues that Tsune ‘081 “is capable of using a belt and pulley system with the motor in order to drive the second gear 74... Tsune ‘081 does

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not disclose how the motor is connected to the second gear 74... The appellant's argument is flawed because the motor is not shown in figure 7 of Tsune '081, and there is no description of how the motor and the second gear 74 are connected. Moreover, it appears from figure 7 of Tsune '081 that the second gear 74 is driven by an assembly that is below the second gear 74, and spaced away from the backlash assembly 65, giving credence to the argument that the motor must be spaced away from the backlash assembly."

Applicants/Appellant readily admit that the motor is spaced away from the backlash assembly and below the second gear. Applicants/Appellant however do not agree that the motor is necessarily connected to gear 74 via a belt.

Instead, Applicants/Appellant submit that the motor may have a motor shaft with one or more intervening gears that mesh with second gear 74, thus transmitting the motor's rotational action to second gear 74. With such arrangement, it is not necessary for a saw with a backlash eliminator to have a belt and pulley system. In other words, the Examiner is incorrect in assuming that "the belt and pulley are required in the configuration of any apparatus that has the backlash eliminator."

Regardless of the above, the Examiner still believes "it would have been obvious to provide a belt in Ushiwata as taught by Tsune in order to provide a backlash eliminator assembly, which eliminates backlash between gears" even though (a) the Tsune belt is not used in a backlash eliminator assembly, as admitted by the Examiner, and (b) not all backlash eliminator

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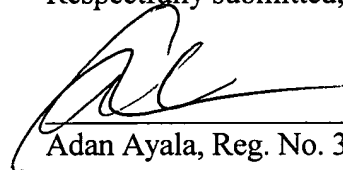
UTILITY PATENT

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assemblies require a belt, as shown by Tsune '081. Applicants/Appellant submit that, since a belt is not used in the Tsune backlash eliminator assembly or necessary for such backlash eliminator assembly to exist in a saw, a person of ordinary skill in the art would not have added the Tsune belt to Ushiwata to provide a backlash eliminator assembly, as alleged by the Examiner. Therefore, the Examiner's rationale for combining Ushiwata and Tsune is invalid.

Because the Examiner has failed to identify a valid motivation to combine Ushiwata and Tsune, no proper *prima facie* case of obviousness can be made. Therefore, Claim 1 is patentable over Ushiwata/Tsune. Accordingly, Applicant/Appellant urges the Board to reverse the Examiner's improper rejection of the claim under Ushiwata/Tsune and to allow such claim.

Respectfully submitted,



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